



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,992	01/17/2002	Denwood E. Ross III	VTN-0572	4178

27777 7590 02.05.2003

AUDLEY A. CIAMPORCERO JR.  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

GAGLIARDI, ALBERT J

ART UNIT	PAPER NUMBER
----------	--------------

2878

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/051,992

Applicant(s)

ROSS ET AL.

Examiner

Albert J. Gagliardi

Art Unit

2878

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action, or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s): \_\_\_\_\_.
10. ☒ Other: See attached.

**EXAMINER'S COMMENT ON SUBMISSIONS**

*Affidavit*

1. The declaration filed on 21 January 2002, has not been considered because it is not timely filed. The examiner notes that the exhibit is not being submitted for the purpose of overcoming a new ground of rejection (the examiner's notes that the declaration relates to earlier grounds of rejection) or requirement made in the final rejection (though the previous affidavit was viewed as insufficient by the examiner and reasons were given for why the declaration was viewed as insufficient, no actual requirements were made regarding the declaration). See MPEP 715.09.

The examiner also notes that, even though a thorough consideration of the declaration has not been made, the declaration seems to suffer from the same problems as the original declaration, i.e., no statement of facts that actually allege or provide evidence that the invention as claimed was completed and reduced to practice prior to the effective date of the *Duggan* reference. At most, the statements merely seem to provide a foundation for considering the exhibits, and a conclusory statement as to what they show. Conspicuously absent are even a general allegation or statement by the inventor that the invention was actually reduced to practice before the effective date, or any facts supporting the correctness of such an allegation. There are no statements that the invention was reduced to practice; that a working prototype was built before the effective date; that printed circuit boards, even if made or ordered, were tried and tested in a working model; that the model, even if tested actually worked; or that any model made or tested before the effective date is a model that is commensurate with the invention as presently claimed.

Regarding the Exhibits, the examiner notes that the Exhibits themselves do not provide any evidence that the invention as claimed was reduced to practice prior to the effective date.

The examiner notes that the Exhibits, including the "Invention Disclosure", drawings of a possible prototype, and an invoice for a "Lens Detection Systems", do not, in and of themselves, show "reduction to practice" of the "claimed subject matter" (i.e., no mention of a non-imaging detector, no mention of fluorescence, absorption, or reflection, or no description or showing of how the processor is arranged so as to determines the location of a product, for example).

As such, even if the declaration was considered, it seems from a merely cursory review, that it is insufficient to show conception and reduction to practice.

2. The examiner notes that the declaration also appears insufficient, superficially at least, because it has not been made by all of the inventors. See MPEP 715.04.

#### ***Double Patenting***

3. The examiner notes that while the issue is not being considered in this advisory action, it appears that one or more claims are directed to the same invention as claimed in U.S. Patent No. 6,246,062 B1, which, according to the affidavit (paragraph 3), commonly assigned. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention may need to be resolved. The issue of double patenting may also apply.

#### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert J. Gagliardi whose telephone number is (703) 305-0417. The examiner can normally be reached on Monday thru Friday from 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (703) 308-4852. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Application/Control Number: 10/051,992

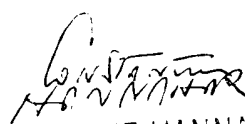
Page 4

Art Unit: 2878

• Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

AJG

February 3, 2003

  
CONSTANTINE HANNAHER  
PRIMARY EXAMINER  
GROUP ART UNIT 2878